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| 27386 7590 06/03/2010 GERSTENZANG, WILLIAM C. NORRIS MCLAUGHLIN & MARCUS, PA 875 THIRD AVE, 8TH FLOOR NEW YORK, NY 10022 | | | | |
| EXAMINER NELSON, MICHAEL B | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/578,231

Applicant(s)

HUSEMANN ET AL.

Examiner

MICHAEL B. NELSON

Art Unit

1783

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendments filed on 03/04/10 have been entered. Claims 1-8 are currently under examination on the merits. The previous 112 2nd paragraph rejections have been maintained.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite "heat-activable" which is vague and indefinite in that it is unclear if the activity that the heat is meant to start is the setting of the adhesive (i.e. thermosetting) or if the heating of the polymer is only meant to melt the polymer but not set it. The remainder of the claims are likewise rejected for being dependent on the above mentioned claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1, 3, 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feichtmeier et al. (U.S. 6,350,791), and further in view of Kelch et al. (U.S. 2002/0068182).

Regarding claim 1, Feichtmeier et al. discloses a thermosettable adhesive composed of a thermoplastic polyester resin and an epoxy resin (C3, L5-L15). Many epoxy resins are disclosed, inter alia, Araldite ® 6010, Epon ® 825 etc. (C4, L60-C5, L45), which are same as those listed as equivalent epoxy candidates in the instant spec on pages 5 and 6. The polyester resin is disclosed as being a copolyester (C5, L45-C6, L35).

Feichtmeier et al. does not disclose using a copolyester in its thermosettable adhesive with the instantly claimed properties.

Kelch et al. discloses using GRILTEX ® 9 copolyester in an hot melt adhesive layer because of its advantageous rheological properties, inter alia, low melt viscosities ([0027]-[0030]). From the instant specification (Example 1, page 9), the GRILTEX ® 9 copolyester used with the epoxy resins of Feichtmeier et al. would produce an adhesive with the instant claimed properties.

The inventions of both Feichtmeier et al. and Kelch et al. are drawn to the field of thermosetting adhesives and therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to have modified the adhesive composition of Feichtmeier et al. by using the GRILTEX ® 9 copolyester as taught by Kelch et al. for the purposes of imparting improved rheological properties.

The modified teachings of Feichtmeier et al. (i.e. using GRILTEX ® 9 as the copolyester) read on the instant claimed rheological properties in that modified Feichtmeier et al. has GRILTEX ® 9 copolyester and the epoxy equivalents of EPR 0191 at weight ratios (30% to 80% polyester and 5 to 80% epoxy, C3, L10-20) which overlap the weight ratio as disclosed in Example 1 (instant specification, page 9), which posess the instant claimed rheological properties.

Modified Feichtmeier et al. does not explicitly disclose the specific rheological properties of the adhesive sheet as in instant claim 1. However, in light of the substantially identical adhesive composition as taught by modified Feichtmeier et al. with the instant adhesive composition from the example in the claims, it will possess the claimed properties, absent any

objective evidence to the contrary. See MPEP 2112 (In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980).

The adhesive of modified Feichtmeier et al. is "heat-activable" in the sense that it can be melted for application to the desired substrate and it is also considered "heat-activable" in the sense that it can be thermoset at a higher temperature (Examples 1-7, C18, L50-C20). This combined thermal effect is achieved through a combination of thermosetting polymers (C3, L35-45) and thermoformable polymers (C3, L45-60). Either of these polymers (thermosetting or thermoformable) would be considered "heat activable."

Regarding claims 3 and 4, modified Feichtmeier et al. discloses all of the limitations as set forth above. Additionally the Feichtmeier et al. discloses a thermosettable adhesive composed of a copolyester resin (C5, L45-C6, L35) and an epoxy resin (C4, L60-C5, L45).

Regarding claim 7, Feichtmeier et al. discloses a thermosettable adhesive composed of a thermoplastic polyester resin and an epoxy resin at (C3, L5-15). Many epoxy resins are disclosed, inter alia, Araldite ® 6010, Epon ® 825 etc. (C4, L60-C5, L45), which are of the same as those listed as equivalent epoxy candidates in the instant spec on pages 5 and 6. The polyester resin is disclosed as being a copolyester (C5, L45-C6, L35). Feichtmeier et al. also discloses that the adhesive layer be used with a release film as a tape (C13, L20-35). Feichtmeier et al. does not disclose using GRILTEX ® 9 copolyester in its thermosettable adhesive.

Kelch et al. discloses using GRILTEX ® 9 copolyester in an hot melt adhesive layer because of its advantageous rheological properties, inter alia, low melt viscosities ([0027]-[0030]).

The inventions of both Feichtmeier et al. and Kelch et al. are drawn to the field of thermosetting adhesives and therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to have modified the adhesive composition of Feichtmeier et al. by using the GRILTEX ® 9 copolyester as taught by Kelch et al. for the purposes of imparting improved rheological properties.

The modified teachings of Feichtmeier et al. (i.e. using GRILTEX ® 9 as the copolyester) read on the instant claimed rheological properties in that modified Feichtmeier et al. has GRILTEX ® 9 copolyester and the epoxy equivalents of EPR 0191 at weight ratios (30% to 80% polyester and 5 to 80% epoxy, C3, L10-20) which overlap the weight ratio as disclosed in Example 1 (instant specification, page 9), which possesses the instant claimed rheological properties.

Modified Feichtmeier et al. does not explicitly disclose the specific rheological properties of the adhesive sheet as in instant claim 1. However, in light of the substantially identical adhesive composition as taught by modified Feichtmeier et al. with the instant adhesive composition from the example in the claims, it will possess the claimed properties, absent any objective evidence to the contrary. See MPEP 2112 (In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980)).

8. Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feichtmeier et al. (U.S. 6,350,791) in view of Kelch et al. (U.S. 2002/0068182), and further in view of Vieilledent (U.S. 4,701,236).

Regarding claims 2 and 8, modified Feichtmeier et al. discloses all of the limitations as set forth above.

Modified Feichtmeier et al. does not disclose that the thickness of the film be between 10 and 100 or 20 and 80 micrometers.

Vieilledent discloses an adhesive for use with chips and cards with a thickness of 50 micrometers, which exemplifies the instant claimed ranges (C4, L40-56).

The inventions of both modified Feichtmeier et al. and Vieilledent are drawn to the field of adhesives and therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to have modified the adhesive of modified Feichtmeier et al. by using the thickness as taught by Vieilledent for the purposes of using the adhesive in a way that would adequately secure a chip to a card.

9. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feichtmeier et al. (U.S. 6,350,791) in view of Kelch et al. (U.S. 2002/0068182), and further in view of Haghir-Tehrani (U.S. 4,897,534).

Regarding claims 5 and 6, modified Feichtmeier et al. discloses all of the limitations as set forth above.

Modified Feichtmeier et al. does not disclose a method of using the adhesive to secure a chip to a card.

Haghiri-Tehrani discloses a method of using the adhesive to secure a chip to a card, wherein the card is a polyimide (C1, L20-30) and the chip module is PVC (C3, L35-45).

The inventions of both modified Feichtmeier et al. and Haghiri-Tehrani are drawn to the field of adhesives and therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to have used the adhesive of modified Feichtmeier et al. for securing chips to cards as taught by Haghiri-Tehrani for the purposes of applying the invention to more marketable fields.

Response to Arguments

10. Applicant's arguments filed on 03/04/10 have been considered but are not persuasive.
11. Applicant argues that the term "heat activable" is not vague and indefinite. The examiner disagrees. Applicant argues that heat-activatable is used in the USPTO's classification system. While this is the case, the use of the term in the class is to distinguish it from pressure sensitive adhesives and does not clarify the vagueness in the instant application where the term appears to be used by the applicant to distinguish between thermoplastic and thermosetting adhesive compositions (both of which are heat activable as opposed to pressure sensitive). Applicant also argues that the term is defined in another patent application. The examiner does not find that the cited portion is an adequate definition. The paragraph describes the qualities of a "heat activable adhesive layer" in a particular layer as having certain properties but does not seem to indicate that these properties are necessary characteristics a material must have for it to qualify as a heat activable adhesive. In short the cited paragraph is describing one reference's idea of what type

of heat activable adhesive should be used in their invention and does not limit what the term heat activable means. The examiner considers one having ordinary skill in the art would consider under the broadest reasonable interpretation that a heat activable adhesive is an adhesive that is activated by heat. The confusion in terms of the 112 2nd paragraph rejection is that the applicant intends to be making further specification with respect to whether the adhesive is thermosetting or not and since the "activation" by heat could be the setting of the resin, the term is vague in that it would include thermosetting resins and yet it is being argue to preclude them. If applicant intends to limit their adhesive composition to only thermoplastic resins they should do so via an amendment which clarifies the nature of their adhesive.

12. Turning from the 112 2nd rejection to the substantive arguments by the applicant that a thermosetting resin (as in Feichtmeier) could not be a "heat activable adhesive" the examiner, as stated above, maintains that a heat activable resin can in fact be thermosetting and be "activated" by the thermal setting of the resin composition. In support please see U.S. 4,822,443 at C1, L55-65: "the use of heat-activated adhesives of a type well known in the art which are thermosetting and thermoplastic in nature." Also see, U.S. 4,249,978, in the abstract the reference describes thermosetting heat-activated adhesives. These references show that heat activable adhesives could be thermosetting in nature. Therefore the thermosetting resin of Feichtmeier does in fact read on the claims in the sense that the adhesive is set, and the two articles are adhered, when heat is applied.

13. Applicant also argues against the combination of Feichtmeier with the Griltex of Klech on the grounds that the two references are non-analogous and there is no motivation to combine. First, the two references are analogous because they are both directed towards adhesive

compositions. Second, there is motivation expressed in the Feichtmeier reference to use a thermoformable polyester copolymer (i.e. copolyester) in the adhesive composition (C5, L45-55). The material is to be selected based on its flow characteristics (C5, L45-60). Since Klech discloses a specific copolyester for use in adhesive compositions like Feichtmeier that has specific melting points and molecular weights which allow for specific tailoring of the rheological properties of the final adhesive composition. Hence the motivation to use the specific type of copolyester in Feichtmeier would have been obvious to one having ordinary skill.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL B. NELSON whose telephone number is (571) 270-3877. The examiner can normally be reached on Monday through Thursday 6AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patricia L. Nordmeyer/
Primary Examiner, Art Unit 1783

/MN/
05/29/10